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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,401	04/20/2004	Charles Reeves Little II	MS1-2006US	4534
22801	7590	11/16/2007		
LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No. 10/828,401		Applicant(s) LITTLE, CHARLES REEVES	
Examiner Joseph E. Averline		Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed

after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s), \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2004/04/20
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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6. Claim 11 is a means-plus-function claim. As dictated by the specification, the invention can be embodied in software alone (§ 54), which fails to establish a statutory category of invention. Correction is required.

7. Claims 12-16 are rejected for similar reasons as stated above.

8. Claim 17 recites a media transition engine comprising a media detector, a presence detector, and a media integrator, which are all merely software programs, which provides the engine as software, per se, and, as such, fails to establish a statutory category of invention. Correction is required.

9. Claims 18-27, and 35-37 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-8, 10, 17-19, 24, 25, 27, 28, 31, 32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogle et al. (USPN 6,430,604) (hereinafter Ogle).

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### DETAILED ACTION

1. Claims 1-39 are presented for examination; claims 1, 11, 17, 28, 36, and 38 independent.

### *Information Disclosure Statement*

2. The IDS dated April 20, 2004 has been considered. See enclosed PTO-1449.

### *Specification*

3. Claims 28-34 are objected to because of the following informalities:
4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the Specification does not provide proper support for the term "computer readable medium".

### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-27, and 35-37 are rejected under 35 U.S.C. 101 because they fail to establish a statutory category of invention.

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11. Referring to claim 1, Ogle discloses a method comprising:  
detecting from within a computing environment for sending a message via a first communication medium, a presence (i.e. entries in the registry) of a potential message recipient who can be reached via a second communication medium (i.e. if entries are found corresponding to the available communications medium) (Figure 5A, refs. 515, 520); and  
automatically invoking the second communications medium in response to the detecting (i.e. deliver the message using the available medium) (Figure 5A, ref. 545).
12. Referring to claim 2, Ogle discloses contemporaneously running multiple communications programs for instantly sending the message via one of the communications programs (i.e. invoke appropriate transformation engine to transform the message) (Figure 5A, ref. 540; col. 11, lines 35-40).
13. Referring to claim 6, Ogle discloses offering a choice of sending the message to the potential recipient via the second communication mechanism (i.e. a list of available choices to send the message to the user) (Figure 5C, ref. 585).
14. Referring to claim 7, Ogle discloses displaying a menu (i.e. list) of message transfer options including an option to send the message via the second medium (Figure 5c, ref. 585).

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15. Referring to claim 8, Ogle discloses the number of message transfer options on the dynamic menu depends on the number of communications media to which a potential recipient is present (i.e. if a user is available to receive a message via the medium, it is added to the list, and then the list is sent to the user to choose which particular media to send the message through) (Figure 5c).

16. Referring to claim 10, Ogle discloses sensing presence of multiple potential recipients, each present in one or more communication media (Figure 3); invoking multiple communications media in response to the detecting (i.e. the transformation engine corresponding to the particular media is invoked) (col. 11, lines 35-40); and sending a message to each of the multiple potential recipients via a communication medium to which the potential recipient is present (Figure 4, ref. 406).

17. Claims 17-18 are rejected for similar reasons as stated above.

18. Referring to claim 19, Ogle discloses the media detector uses one or more address book databases (Figure 3).

19. Claims 24 and 25 are rejected for similar reasons as stated above.

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20. Referring to claim 27, Ogle discloses displaying a single user control button for initiating messaging via one of the mediums which the recipient is present, and removing the button when the user is not present on the medium (i.e. displaying a list to the recipient indicating the available communication medium) (Figure 5C, ref. 585).

21. Claims 28, 31, 32, and 35 are rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 9, 11-16, 20-23, 26, 29, 30, 33, 34, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle in view of Day et al. (US 2005/0027839) (hereinafter Day).

23. Referring to claim 3, Ogle discloses the invention substantively as disclosed in claim 1. Ogle discloses sending a list of available communications medium available to the potential recipient (Figure 5C). Ogle does not explicitly disclose transitioning to a user interface of the second communications medium. In analogous art, Day discloses another message transmission system which transitions the user from an instant message application to an email application in response to a particular condition (§ 45).

It would have been obvious to one of ordinary skill in the art to combine the teaching of Ogle with Day in order to combine the well known user interface transition system of Day with the message sender of Ogle, thereby achieving predictable results of improved messaging session communication as supported by Day (§ 7).

24. Claim 4 is rejected for similar reasons as stated above. Furthermore Day discloses transitioning to a message composition environment associated with the second communications medium (i.e. an email application) (§ 45).

25. Referring to claim 5, Ogle-Day discloses transferring at least part of the unsent message from a message composition environment associated with the first communications medium to a message composition environment associated with the second communications medium (i.e. import the currently typed text from the instant message to the email window) (Day: § 45).

26. Referring to claim 9, Ogle discloses the invention as described above. Ogle does not disclose the control option is used to transfer message composition to the second communication medium. In analogous art Day discloses another message transmission system which transitions the user from an instant message application to an email application in response to a selection by a user (§ 45). It would have been obvious to one of ordinary skill in the art to combine the teaching of Ogle with Day in order to combine the well known user interface transition system of Day with the



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message sender of Ogle, thereby achieving predictable results of improved messaging session communication as supported by Day (¶ 7).

27. Claims 11-16, and 20-23 are rejected for similar reasons as stated above.

28. Referring to claim 26, Ogle-Day disclose the invention substantively as described in the claims above. Ogle-Day do not explicitly disclose the dynamic menu includes an instant reply option for multiple potential recipients, wherein users which are available for instant messaging are initiated into a chatroom, sending the users unavailable to instant message by their communications medium they are present, and sending email by default, however these particular features are well within the skills of one of ordinary skill in the art since one of ordinary skill in the art knows that a recipient has the ability to respond to a message in the same medium in which it was received (i.e. replying to an email, calling back a user who left a voicemail, etc.). By this rationale, one of ordinary skill in the art would find replying to the message well within the abilities of one of ordinary skill in the art.

29. Claims 29, 30, 33, 34, and 36-39 are rejected for similar reasons as stated above.

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**Conclusion**

30 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Joseph E. Avellino, Examiner  
November 9, 2007